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EXAMINER

KALINOWSKI, A

ART UNIT

PAPER NUMBER

2166

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04/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/010,919

Applicant(s)
Ordish et al

Examiner
Alexander Kalinowski

Group Art Unit
2166



☒ Responsive to communication(s) filed on Feb 7, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 43-117 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 43-49, 52, 54, 55, 59, 60, 62-74, 77, 79, 80, 84, 85, 87-99, 102, 104, 1 is/are rejected.

☒ Claim(s) 50, 51, 53, 56-58, 61, 75, 76, 78, 81-83, 86, 100, 101, 103, 106-108, a is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 43-117 are presented for examination. Applicant filed a terminal disclaimer on 3/21/00. Applicant amended the specification by canceling pages 1-5. Therefore, the Examiner withdraws the objection to the specification. Applicant also requested reconsideration of the grounds of rejection of claims 43-117 in a request for reconsideration filed on 2/7/01. After careful consideration of Applicant's arguments, the Examiner finds the Applicant's nonpersuasive and maintains the grounds of rejection of claims 43-117 as explained in detail below.

Response to Arguments

2. Applicant amended the specification by canceling the first five pages of the specification (pages 1-5). Therefore, the Examiner withdraws the objection to the specification.

3. With respect to the 43-45, 48, 49, 52, 54, 59, 62-70, 73, 77, 79, 80, 84, 87-95, 98, 99, 104, 109, and 112-117, Applicant argues that the Silverman fails to disclose "a fourth signal indicating acknowledgment of an acknowledgment ..." (see claims 43, 68, 92), "sending from the network to the first and second workstations an indication that the network acknowledges the acknowledgment ..." (see claims 59 and 84), "sending from the networked processor to the first and second workstations an indication that the networked processor received acknowledgment of the transaction" (see claims 59 and 84), "an output for outputting a first signal to said network ..." or "a second signal ..." (see claims 62 and 87), "receiving an acknowledgment from said network indicating that a workstation originating ..." (see claims 63 and 88), "fourth" and "fifth"

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transaction messages (see claim 93), “sending from the network to the first and second workstations an indication that the network acknowledges the acknowledgment ...” (see claim 104), “sending from the networked processor to the first and the second workstations an indication ...”(see claim 109), “said receiver also receiving a third transaction message wherein said third transaction message”(see claim 112), “receiving an acknowledgment from said network indicating that a workstation originating said first transaction message ...”(see claim 113), and “at least a third transaction message” and “at least a fourth transaction message” (see claim 117) limitations. The Examiner notes that the previous office action (Paper No. 13) addressed every one of the aforementioned limitations and the Examiner provided citations to passages in the Silverman reference that disclosed the limitations. Furthermore, Applicant has merely asserted that the reference fails to teach the references without providing arguments or an explanation as to why the Applicant feels that the cited teachings of Silverman fail to disclose the aforementioned limitations as required by the MPEP (see MPEP 714.02 and 37 CFR 1.111 (b)). The Examiner provided citations to Silverman disclosing the aforementioned limitations. The Examiner refers the Applicant to the detailed grounds of rejection of claims 43-117 based on 35 USC 102 and 35 USC 103 which are repeated below. Therefore, Applicants arguments are nonpersuasive.

4. With respect to claims 67, 68, 79, 84, 87, 88, 92, 93, 104, 109, 112, 113 and 117, Applicant traverses the Examiner’s rejection of the claims. The Examiner notes that the limitations of claims 67, 68, 79, 84, 87, 88, 92, 93, 104, 109, 112, 113 and 117 were explicitly addressed addressed in the rejection of claims 43, 54, 59, 62, 63, and 67. The Examiner notes that Applicant

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merely asserted the Examiner failed to disclose all the limitations of claims 67, 68, 79, 84, 87, 88, 92, 93, 104, 109, 112, 113 and 117 and Applicant failed to provide any arguments or explanations disclosing which particular limitations found in claims 67, 68, 79, 84, 87, 88, 92, 93, 104, 109, 112, 113 and 117 were not addressed by the rejection of the claims (see MPEP 714.02 and 37 CFR 1.111 (b)). It is unclear to the Examiner which limitations of claims 67, 68, 79, 84, 87, 88, 92, 93, 104, 109, 112, 113 and 117 were not addressed by the previous office action (Paper No. 13). Therefore, the Examiner finds that all the limitations in the claims were disclosed by the prior art in the previous office action and Applicant's arguments are deemed nonpersuasive.

5. With respect to Applicant's arguments that the Examiner incorrectly asserted the IXM message is an acknowledgment signal as claimed, the Examiner respectfully disagrees. First, the IXM message is sent to all parties whether they were involved in this transaction or not (Col. 16, lines 1-8). Therefore, the message is sent to the parties involved in the transaction which are the parties that were claimed by Applicant in the aforementioned claims. Furthermore, the IXM message is an acknowledgment message in that the message instructs the parties that a transaction has occurred (see col. 14, lines 14-41). The IXM message acknowledges the acknowledgment message and is sent to all parties' workstations which presumably includes the claimed workstation since the message instructs the parties, including the parties involved in the proposed bid or offer, that the proposed transaction has been completed successfully and the trading books must be updated accordingly (see col. 14, lines 14-41). Therefore, Applicant's arguments directed to the IXM message are deemed nonpersuasive.

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6. Finally Applicant's argue that since claims 46, 47, 55, 60 , 71 72, 80, 85, 96, 97, 105 and 110 are dependent on independent claims in the application and since the independent claims are patentably distinguishable over the prior art based on Applicant's arguments, therefore, the dependent claims are patentably distinguishable over the prior art. The Examiner respectfully disagrees. Since the Examiner found Applicant's arguments directed to the independent claims to be nonpersuasive, the Examiner maintains the rejection of the independent claims. The Examiner did not find the independent claims to be distinguishable over the prior art. Therefore, the rejection of claims 46, 47, 55, 60 , 71 72, 80, 85, 96, 97, 105 and 110 are maintained by the Examiner. Applicant's arguments are deemed nonpersuasive.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 43-45, 48, 49, 52, , 54, 59, 62-70, 73, 74, 77, 79, 80, 84, 87-95, 98, 99, 104, 109, and 112-117 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverman et al., Pat. No. 5,136,501 (hereinafter Silverman).

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With respect to claim 43, Silverman discloses a system for exchanging signals relating to at least a bid and an offer (see abstract), the system comprising:

- a network (unit 22) connected to workstations, units (26a) and (26b) (Fig. 1) ;

- a first workstation (unit 24a) of said workstations, said first workstation sending a first signal to said network signaling a bid in response to an initial offer (i.e. trader decides to enter a bid or enter an offer in an effort to complete matching a transaction. Key station 24a submits bid transaction to central system 20)(see Fig. 6 and col. 14, line 60 - col. 15, line 6);

- a second workstation of said workstations, said second workstation receiving a second signal indicative of said bid from said network (Directed Msg. B) and for sending an acknowledgment of said received bid to said network (Directed Msg.-Ack B)(i.e. directed message sent to the counterparty workstations and associated directed message acknowledgment) and (see Fig 6 and col. 15, lines 36-43 and lines 56-60)

- said network sending at least a third signal to said first workstation and at least a fourth signal to said second workstation, said at least third and said at least fourth signals indicating acknowledgment of said acknowledgment from said second workstation (i.e. the system generates directed messages to the counterparties, the associated directed message acknowledgments and the IXM update broadcast message 132 to all keystations 24 including 24a and 24b)(col. 15, lines 36-42 and col. 16, lines 1-8).

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With respect to claim 44, Silverman discloses the system according to claim 44, wherein said at least third signal includes a first purchase confirmation signal and said at least fourth signal includes a second purchase confirmation signal (i.e. broadcast message to all workstations 24)(col. 15, lines 36-42 and col. 16, lines 1-8).

With respect to claim 45, Silverman discloses the system according to claim 43, further comprising at least one storage node for recording the completion of a purchase relating to said bid (i.e order database 114 and 116)(col. 13, lines 14-26).

With respect to claim 48, Silverman discloses the system according to claim 43, said network generating and transmitting an acknowledgment of the receipt of the first signal (i.e. CMD-Ack 122)(Fig. 6).

With respect to claim 49, Silverman discloses the system according to claim 48, wherein said acknowledgment of the receipt of said first signal and said second signal indicative of said bid are match notification signals (directed Msg. A 124 and Directed Msg. B 128) generated by at least one computer unit 20 in said network (see Fig. 6).

With respect to claim 52, Silverman discloses the system according to claim 43, wherein said network further comprises:

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a computer for matching bids and offers from said workstations in accordance with predetermined matching criteria (i.e. the central system 20 validates the transaction request and attempts to find matches between this new entry and other bids and offers posted in the system book subject to counterparty credit limits)(col. 7, lines 5-13).

With respect to claim 54, Silverman discloses a method for acknowledging the receipt signals relating to bids and offers in an electronic trading system, said electronic trading system including a network and at least first and second workstations coupled to a network (see abstract and Fig. 6), the method comprising the steps of:

sending an offer from the first workstation to the network in response to an initial bid (i.e. trader decides to enter a bid or enter an offer in an effort to complete matching a transaction. Key station 24a submits bid transaction to central system 20)(see Fig. 6 and col. 14, line 60 - col. 15, line 6);

receiving the offer from said network at the second workstation (i.e. directed Msg. B 128)(Fig. 6);

sending from the second workstation to said network an acknowledgment of the receipt of the offer (i.e. Directed Msg.-Ack B)(Fig. 6); and

sending from the network to the first and second workstations an indication that the network acknowledges the acknowledgment from said second workstation (i.e. Broadcast Msg. 132)(Fig. 6).

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With respect to claim 59, Silverman discloses a computer-readable medium having computer-executable instructions for performing steps (see abstract, Fig. 1 and Fig. 6) comprising:

receiving at a networked processor an offer from a first workstation in response to an initial bid (i.e. trader decides to enter a bid or enter an offer in an effort to complete matching a transaction. Key station 24a submits bid transaction to central system 20)(see Fig. 6 and col. 14, line 60 - col. 15, line 6);

sending the offer from the networked processor to a second workstation (i.e. directed Msg. B 128)(Fig. 6);

receiving an acknowledgment of a transaction based on the offer from the second workstation at the networked processor (i.e. Directed Msg.-Ack B)(Fig. 6); and

sending from the networked processor to the first and second workstations an indication that the networked processor received the acknowledgment of the transaction (i.e. Broadcast Msg. 132)(Fig. 6).

With respect to claim 62, Silverman discloses a workstation participating in the exchange of signals, the signals including at least a bid and an offer, the workstation connected to a network, said network connected to at least a second workstation (see abstract and Fig. 1), said workstation comprising:

a receiver unit 24a for receiving an initial offer (i.e. trader can decide whether to enter a bid or enter an offer in an effort to complete matching a transaction) (see Fig. 6 and col. 6, line 61 -col. 7, line 2);

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a processor unit 20 for processing said initial offer (col. 7, lines 5-13);

an output for outputting a first signal to said network, said first signal signaling a bid in response to said initial offer (i.e. trader decides to enter a bid or enter an offer in an effort to complete matching a transaction. Key station 24a submits bid transaction to central system 20)(see Fig. 6 and col. 14, line 60 - col. 15, line 6);

said receiver also receiving a second signal wherein said second signal indicates the acknowledgment of a receipt of said first signal by said second workstation (i.e. Broadcast Msg 132)(Fig. 6).

With respect to claim 63, Silverman discloses a computer-readable medium having- computer-executable instructions for performing steps associated with a purchase comprising a bid and an offer (see abstract and Fig. 1) comprising:

transmitting to a network an offer from a first workstation in response to a received initial bid (i.e. trader can decide whether to enter a bid or enter an offer in an effort to complete matching a transaction) (see Fig. 6 and col. 6, line 61 -col. 7, line 2); and

receiving an acknowledgment from said network indicating that a workstation originating said initial bid has acknowledged said transmitted offer (i.e. Broadcast Msg 132)(Fig. 6).

With respect to claim 64, Silverman discloses the computer readable medium according to claim 63, having further computer readable instructions comprising the step of:

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processing said acknowledgment as an acceptance of said transmitted offer (i.e. broadcast Msg 132)(Fig. 6).

With respect to claim 65, Silverman discloses the system according to claim 43, wherein said third signal and said fourth signal indicate that a transaction relating to said bid is complete (i.e. Broadcast Msg. 132)(Fig. 6).

With respect to claim 66, The method according to claim 54, wherein the indication that the network acknowledges the acknowledgment from said second workstation signifies the completion of a transaction relating to said bid (i.e. Broadcast Msg. 132)(Fig. 6).

Claims 67, 68, 79, 84, 87, 88, 92, 93, 104, 109, 112, 113 and 117 are similar to claims 43, 54, 59, 62, 63, and 67 and are rejected on the same basis.

Claims 69, 70, 73, 74, 77, 89, 90, 91, 94, 95, 98, 99, and 114-116 recite the substantially the same limitations as claims 44, 45, 48, 49, 52, 64-66 and the claims are rejected on the same basis.

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 46, 47, 55, 60, 71, 72, 80, 85, 96, 97, 105 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al., Pat. No. 5,136,501.

With respect to claim 46, Silverman discloses the system according to claim 43.

Silverman does not explicitly disclose

wherein prior to the transmission of said first signal by said first workstation, said second workstation transmits said initial offer to said network.

However, Silverman does disclose a user of a first workstation decides to enter a bid or enter an offer in an effort to complete matching a transaction (col. 6, lines 61-63). Since the system matches the bid or offer of the user of the first workstation with the initial bid or offer of the second workstation, the user of the first workstation could have entered a bid or offer in response to the initial bid or offer of the user of the second workstation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein prior to the transmission of said first signal by said first workstation, said second workstation

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transmits said initial offer to said network within the Silverman system since the first workstation submits a bid or response in an effort to complete a matching transaction (col. 6, lines 61-63).

With respect to claim 47, Silverman does not explicitly disclose the system according to claim 46, said network generating and transmitting an acknowledgment of said initial bid to said second workstation.

However, Silverman does disclose the network generating and transmitting an acknowledgment of the first workstation sending a first signal to said network signaling a bid in response to an initial offer (see Fig. 6, CMD-ACK 122). The purpose of the acknowledgment signal is for the network to acknowledge receipt of a transaction signal from the first workstation (col. 8, lines 42-45). Although Silverman does not explicitly disclose a command acknowledgment of the initial transactional signal from the second workstation, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the system according to claim 46, said network generating and transmitting an acknowledgment of said initial bid to said second workstation within Silverman in order to acknowledge receipt of a transactional message from the second workstation (col. 8, lines 42-45).

With respect to claim 55, Silverman does not explicitly disclose the method according to claim 54, further comprising the steps of:

 sending the initial bid from the second workstation to the network.

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However, Silverman does disclose a user of a first workstation decides to enter a bid or enter an offer in an effort to complete matching a transaction (col. 6, lines 61-63). Since the system matches the bid or offer of the user of the first workstation with the initial bid or offer of the second workstation, the user of the first workstation could have entered a bid or offer in response to the initial bid or offer of the user of the second workstation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include sending the initial bid from the second workstation to the network within the Silverman system since the first workstation submits a bid or response in an effort to complete a matching transaction (col. 6, lines 61-63).

Silverman does not explicitly disclose

receiving an acknowledgment of the initial bid from the network at the second workstation.

However, Silverman does disclose the network generating and transmitting an acknowledgment of the first workstation sending a first signal to said network signaling a bid in response to an initial offer (see Fig. 6, CMD-ACK 122). The purpose of the acknowledgment signal is for the network to acknowledge receipt of a transaction signal from the first workstation (col. 8, lines 42-45). Although Silverman does not explicitly disclose a command acknowledgment of the initial transactional signal from the second workstation, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the system according to claim 46, said network generating and transmitting an acknowledgment of said initial bid to said

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second workstation within Silverman in order to acknowledge receipt of a transactional message from the second workstation (col. 8, lines 42-45).

With respect to claim 60, Silverman does not explicitly disclose the computer-readable medium of claim 59 having further computer-executable instructions for performing the following steps:

receiving at the networked processor the initial bid from the second workstation.

However, Silverman does disclose a user of a first workstation decides to enter a bid or enter an offer in an effort to complete matching a transaction (col. 6, lines 61-63). Since the system matches the bid or offer of the user of the first workstation with the initial bid or offer of the second workstation, the user of the first workstation could have entered a bid or offer in response to the initial bid or offer of the user of the second workstation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include receiving at the networked processor the initial bid from the second workstation within the Silverman system since the first workstation submits a bid or response in an effort to complete a matching transaction (col. 6, lines 61-63).

Silverman does not explicitly disclose

sending an acknowledgment of the initial bid from the networked processor to the second workstation.

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However, Silverman does disclose the network generating and transmitting an acknowledgment of the first workstation sending a first signal to said network signaling a bid in response to an initial offer (see Fig. 6, CMD-ACK 122). The purpose of the acknowledgment signal is for the network to acknowledge receipt of a transaction signal from the first workstation (col. 8, lines 42-45). Although Silverman does not explicitly disclose a command acknowledgment of the initial transactional signal from the second workstation, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the system according to claim 46, said network generating and transmitting an acknowledgment of said initial bid to said second workstation within Silverman in order to acknowledge receipt of a transactional message from the second workstation (col. 8, lines 42-45).

Claims 71, 72, 80, 85, 96, 97, 105 recite substantially the same limitations as claims 46, 47, 55 and are rejected on the same basis.

Allowable Subject Matter

11. Claims 50, 51, 53, 56-58, 61, 75, 76, 78, 81-83, 86, 100, 101, 103, 106-108 and 111 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion


12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

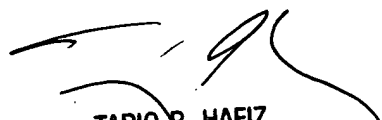
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 8:30 AM to 6:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reached the examiner by telephone is unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax telephone number for this group is (703) 305-0040.

Alexander Kalinowski 

4/7/2001


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